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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09-991,603	11/23/2001	Brett P. Girou	29715.35152R	2243

4743 7590 03/18/2003

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EXAMINER

MOHAMED, ABDEL A

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 03/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,603

Applicant(s)

GIROIR ET AL.

Examiner

Abdel A. Mohamed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 November 2001 and 21 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 23 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

ACKNOWLEDGMENT OF AMENDMENT WITH REISSUE APPLICATION, REISSUE DECLARATION, IDS AND STATUS OF THE CLAIMS

1. The amendment filed 11/23/01 and the information disclosure statement (IDS) and Form PTO-1449 filed 63/21/02 are acknowledged, entered and considered. With respect to the IDS, the references cited therewith on Form PTO-1449 are not provided in the instant application. However, as *per* Applicant's request, since the cited references were considered previously in grandparent application Serial No. 08/927,437 and great-grandparent application Serial No. 08/644,287; pursuant to 37 CFR § 1.98(d), the references cited in Form PTO-1449 in this application have been considered and signed as requested by Applicant. Claims 1-9 are present for examination.

DEFECTIVE REISSUE OATH/DECLARATION, 37 CFR 1.175(a)(1)-THE IDENTIFIED "ERROR" IS NOT APPROPRIATE ERROR

1. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Patentees request that a reissue application has been filed to remove a claimed priority benefit under 35 U.S.C. 120. The patentee is making this correction in order to extend the term of the original patent by stating that the original patent to be partly inoperative or invalid because

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patentee claimed less than patentee had the right to claim in the patent. The patentee states that application (U.S. Ser. No. 09/203,159) now U.S. Patent No. 5,990,086 incorrectly made reference to prior copending applications. The applications are U.S. Ser. No. 08/378,228, filed 1/24/95, U.S. Ser. No. 08/291,112, filed 8/16/94, and U.S. Ser. No. 08/188,221, filed 1/24/94 and should not have been relied upon for priority. By including the additional early applications, the term of '086 patent has been reduced. Removing these applications from the priority claim, the reissue patent issuing from the present reissue application should be granted a patent term 2 years and 3½ months extended beyond that of the original patent. By removal of priority claim(s) under 35 U.S.C. 120, the filing and effective date of U.S. Ser. No. 09/203,159 (U.S. Patent No. 5,990,086) would be December 1, 1998.

Based under 35 U.S.C. 251, the patentee has the right to claim upon surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue. Thus, patentees request for extending the reissue application patent term beyond that of the original patent (i.e., '086 patent) term is improper because 35 U.S.C. 251 only permits reissue for the unexpired part of the term of the original patent.

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NO OFFER TO SURRENDER ORIGINAL PATENT

3. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

REJECTION, DEFECTIVE REISSUE OATH OR DECLARATION

4. Claims 1-9 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

CONCLUSION AND FUTURE CORRESPONDENCE

5. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdel A. Mohamed whose telephone number is (703) 308-3966. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 5:00 p.m. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached on (703) 308-2923. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Christopher S. F. Low

CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1800

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March 12, 2003